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| APPLICATION NO.: | FILING DATE: 98 | ENGEL FIRST NAMED INVENTOR | D | ATTORNEY DOCKET NO. |
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IM21/0724

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BUSHEY EXAMINER

ART UNIT

PAPER NUMBER

07/24/98

DATE MAILED:

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/092,580**

Applicant(s)  
**ENGEL ET AL**

Examiner  
**Scott Bushey**

Group Art Unit  
**1724**



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 15-34 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 15-21 and 23-26 is/are allowed.

☒ Claim(s) 22, 27, and 29-34 is/are rejected.

☒ Claim(s) 28 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2 sheets

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### DETAILED ACTION

1. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 22, line 2, --is-- should apparently be inserted after "liner".

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

(f) he did not himself invent the subject matter sought to be patented.

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

3. Claims 27, and 29-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Engel '992 (Figs. 5 and 6 in particular).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e).

This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37

CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the

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inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 102(e), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered in the instant application were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 102(e) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 27, and 29-34 are rejected under 35 U.S.C. 102(f) or (g) because the applicant did not invent the claimed subject matter. As stated above the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered in the instant application were made absent any evidence to the contrary. Consequently, claims 27, and 29-34 have been presumed as commonly owned by all of the inventors named in the instant application, which would conflict with fact the Engel '992, which names only a single inventor, includes disclosure that clearly anticipates the invention as recited by instant claims 27, and 29-34.

5. Claims 15-21, and 23-26 are allowed.

The prior art of record fails to disclose or suggest the filter element as recited by instant claim 15, wherein the first end cap is in the form of a composite structure including a plastic insert and a polyurethane foam material that encapsulates the first ends of the inner and outer cylindrical

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liners, the plastic insert having radially outwardly directed feet positioned adjacent the inner cylindrical liner of the filter element, the insert being at least partially underneath the foam portion of the first end cap.

6. Claim 22 would be allowable if rewritten to overcome the rejection under 35

U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claim 22 would be allowable based upon its dependency on an allowable independent claim 15.

7. Claim 28 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 28 would be allowable for the same reasons as set forth with respect to claims 15-21, and 23-26 above.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant should especially note the seal structures as taught by Ager et al 5,415,677 and Brown 5,487,767, which each disclose stepped annular sealing surfaces, but which are not designed to cooperate with a housing sealing surface as set forth by applicant's instant claims.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Bushey whose telephone number is (703) 308-3581.

C. SCOTT BUSHEY  
PRIMARY EXAMINER  
GROUP 1300



7-21-98

csb

July 21, 1998